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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,361	09/19/2006	Simon Stewart Mitchinson	42527-104094	1309
23644 7590 10/07/2009 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786				
EXAMINER HELVEY, PETER N.				
ART UNIT 3782		PAPER NUMBER		
NOTIFICATION DATE 10/07/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

Office Action Summary

Application No.

10/593,361

Applicant(s)

MITCHINSON, SIMON STEWART

Examiner

PETER HELVEY

Art Unit

3782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/27/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27 and 29-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27 and 29-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date 9/19/2006 and 11/29/2007
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.84 and 37 CFR 1.121 are required in this application because:

The view number format is improper. View numbers must be preceded by the abbreviation "FIG." Refer to 37 CFR 1.84(u)(1). See Figure(s) 1-42.

The drawings contain improperly overwritten reference characters. Reference characters necessary for indicating a surface or cross section must be underlined to make it clear that a lead line has not been left out by mistake, and if necessary, a blank space should be left in the hatching or shading where the character occurs so that it appears distinct. Refer to 37 CFR 1.84(p(3)) and 1.84(q). See Figure(s) 1B.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the cover, the insert, and the straps pulling from the rear face and folding the top of the bag over must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The description is objected to as containing the following defect(s) under PCT Rule 66.2(a)(iii) in the form or contents thereof: The description does not contain the required headings of the various parts. See MPEP 1823.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 27-29, 31-34, and 36-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the feature that "each strap can pull from the rear face so as to close the bag with the top portions of the bag folded over to touch one another and envelope the content of the main body" was not described in the specification or in the drawings in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 27-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 recites the limitation "the top portions" in line 16. There is insufficient antecedent basis for this limitation in the claim.

Claim 29 recites the limitation "the joins" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 30 and 35 depend on claim 1, which has been canceled in the preliminary amendment dated September 19, 2006. The claims are incomplete due to their dependency on a canceled base claim. See MPEP 608.01 (n) (V).

Claim 33 recites the limitation "the construction material" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 34 recites the limitation "a second part on said second side" resulting in the claim being indefinite because it is unclear if which strap element "said second side" refers to.

Claim 38 recites the limitation "said insert bag" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 28-29, 31-34, and 36-38 are also indefinite for incorporating the indefinite limitations of claim 27 by dependency.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 27, 32, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by *Andelini* (European Patent Application Publication No. 0260229).

Regarding claim 27, *Andelini* discloses a disposable paper rucksack, comprising: a bag (1) for containing items to be carried and at least one carrying

strap (5) affixed to the bag, usable to allow an individual to carry the bag upon the individual's back, wherein the disposable bag comprises a front face and an oppositely directed rear face (Fig. 1, 2), the rear face being adapted to lie adjacent/opposite the back of an individual when in use; wherein, the bag is manufactured from paper and wherein the or each strap is of a length to pass under an arm of the individual and over the shoulder (abstract), the strap being fastened at a lower portion of the bag and upon the front face of the bag (Fig. 1); wherein, each strap is fastened with the bag such that, in normal use, each strap can pull from the rear face so as to close the bag with the top portions of the bag folded over to touch one another and envelope the content of the main body (Fig. 1, 2; abstract).

The limitations "for containing items to be carried" and "usable to allow an individual to carry the bag upon the individual's back" are intended use statements. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

It should be appreciated that the applicant's functional language in the claims does not serve to impart patentability. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. A claim

containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior apparatus teaches all the structural limitations of the claims. In *re* Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d, 1429, 1431-.2 (Fed. Cir. 1997); *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990); *Ex parte Masham*, 2 USPQ 2d 1647 (Bd. Pat. App. & Inter. 1987).

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In *re Hutchison*, 69 USPQ 138.

Regarding claim 32, clearly the bag disclosed by *Andelini* can be made of any paper material, thus meeting the scope of the claim.

Regarding claim 36, *Andelini* further discloses the bag comprising a bottom, reinforced by means of an additional base (3) within said bag (page 3, ll. 15-25).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Andelini* as applied to claim 27 above, and further in view of *Lieberman* (U.S. Patent No. 5,165,111).

Regarding claim 29, *Andelini* discloses all limitations of the claim(s) as detailed above except does not expressly disclose one or more reinforcing tabs are applied to the joins over the join between respective ends of each carrying strap and the disposable bag.

However, *Lieberman* discloses installing a reinforcing tab applied over the joints between the ends of backpack straps and the bag they straps are attached to (Fig. 1; 34; col. 4, ll. 18-23).

All of the component parts are known in *Andelini* and *Lieberman*. The only difference is the combination of all the known elements into a single device by incorporating the reinforcing tabs taught by Sims into the backpack assembly taught by *Andelini*.

Thus, it would have been obvious to one having ordinary skill in the art to add the reinforcing tab taught by *Lieberman* to the strap/backpack joint taught by *Andelini*, since the reinforcing tabs in no way affect the other functions of the backpack and the reinforcing tabs can be used in combination with a backpack to achieve the predictable results of strengthening the joint between the straps and the backpack.

12. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Andelini* as applied to claim 27 above, and further in view of *Haber* (U.S. Patent No. 6,484,917).

Regarding claim 31, *Andelini* discloses all limitations of the claim(s) as detailed above except does not expressly disclose said at least one continuous strap comprising: folding means operative to fold a loop portion of the continuous strap along the length of the continuous strap; and fixing means, operable to maintain a shortened length of the folded strap, the fixing means comprising one of: glue; Velcro; stapling; single-sided adhesive tape; clips; string passing around a button, two pieces of string tied together; punched tabs being inserted into selectable one of a plurality of tab accepting slots; and punched tabs having side extensions inserted into a selectable one of a plurality of tab accepting slots.

However, *Haber* teaches incorporating folding means (40) operative to fold a loop portion of the continuous strap along the length of the continuous strap and fixing means (hook and loop; col. 2, ll. 50-60) operable to maintain a shortened length of the folded strap into the strap assembly of a backpack.

At the time of the invention, it would have been obvious to a person having ordinary skill in the art to incorporate the folding and fixing means taught by *Haber* into the shoulder straps taught by *Andelini*, in order to carry additional objects on the outside of the backpack in the folded straps (col. 1, ll. 35-45).

13. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Andelini* as applied to claim 27 above, and further in view of *Mentken* (U.S. Patent No. 5,957,354).

Regarding claim 33, *Andelini* discloses all limitations of the claim(s) as detailed above except does not expressly disclose the at least one carrying strap

is a paper product and is strengthened by folding along the length of each strap and by attaching the construction material along its length to form a plural ply tape.

However, *Mentken* teaches folding a paper-like strap along a portion of its length and attaching it via adhesive (col. 12, ll. 63-66).

Because *Mentken* and *Andelini* both teach strap structures for disposable backpacks, it would have been obvious to one of ordinary skill in the art to substitute the folded and adhered paper-like strap taught by *Mentken* for the string taught by *Andelini* to achieve the predictable result of holding the backpack on the back of a wearer.

Andelini as modified by *Mentken* discloses all the limitations of the claim(s) except for the strap being a paper product. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the strap out of paper instead of a paper substitute, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

14. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Andelini* as applied to claim 27 above, and further in view of *Pencoske* (U.S. Patent No. 6,237,825).

Regarding claim 34, *Andelini* discloses all limitations of the claim(s) as detailed above except does not expressly disclose at least one of the carrying straps comprises a first strap element and a second strap element, each strap element having a first side and a second side, with a first part on a first side being affixable to a selectable position of a second part on said second side.

However, *Pencoske* teaches providing two halves to a backpack strap connected by a buckle (18). As a note, the threading of one part of a strap element through a buckle for length adjustment, as is well known in the art, resulting in a first part on a first side of one strap element connecting with a second part on both first and second sides of the second strap element, thus meeting the scope of the claim.

At the time of the invention, it would have been obvious to a person having ordinary skill in the art to add the buckle and two part strap configuration taught by *Pencoske* into the shoulder straps taught by *Andelini*, in order to carry adjust the length of the straps (col. 2, ll. 7-10).

15. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Andelini* as applied to claim 27 above, and further in view of *Trevino* (U.S. Patent Application Publication No. 2001/0038023).

Regarding claim 37, *Andelini* discloses all limitations of the claim(s) as detailed above except does not expressly disclose a cover for covering the main disposable bag, said cover being at least one of: mechanically protective; spill resistant; spill repellent; water resilient and water proof.

However, *Trevino* teaches providing a waterproof cover for backpacks (page 1, paragraph [0013]).

At the time of the invention, it would have been obvious to a person having ordinary skill in the art to add the cover taught by *Trevino* to the backpack taught by *Andelini*, in order to protect the backpack from weather (abstract).

16. Claim 38 rejected under 35 U.S.C. 103(a) as being unpatentable over *Andelini* as applied to claim 27 above, and further in view of *Lyman* (U.S. Patent No. 4,988,216).

Regarding claim 38, *Andelini* discloses all limitations of the claim(s) as detailed above except does not expressly disclose an insert for placement within the main disposable bag, said insert bag being at least one of: water proof and water resilient.

However, *Lyman* teaches providing a waterproof insert for a backpack (abstract, col. 3, ll. 4).

At the time of the invention, it would have been obvious to a person having ordinary skill in the art to add the insert taught by *Lyman* to the backpack taught by *Andelini*, in order to keep the contents at a desired temperature (col. 1, ll. 50-55).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER HELVEY whose telephone number is (571)270-1423. The examiner can normally be reached on M-Th 8:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. H./
Examiner, Art Unit 3782
September 28, 2009

/Justin M Larson/
Examiner, Art Unit 3782
10/1/09